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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/756,761	01/14/2004	Laurence S. Harbig	604-706	1504
23117 7590 06/13/2007 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			EXAMINER KANTAMNENI, SHOBHA	
			ART UNIT 1617	PAPER NUMBER
			MAIL DATE 06/13/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/756,761

Applicant(s)

HARBIGE ET AL.

Examiner

Shobha Kantamneni

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-15 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

### DETAILED ACTION

This Office Action is in response to the application filed on 01/14/2004. Claims 1-15 are pending.

#### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 1-2 (in part), 4, 5, 6-15 (in part), drawn to a method of treating a patient for multiple sclerosis comprising administering a therapeutically effective dose of a compound of formula I, wherein two of  $X^1$ ,  $X^2$ , and  $X^3$  are being nitrogen, classified in class 514, subclass 247, 903.
- II Claim 1-2 (in part), 3, 6-15 (in part), drawn to a method of treating a patient for multiple sclerosis comprising administering a therapeutically effective dose of a compound of formula I, wherein  $X^1$ ,  $X^2$ , and  $X^3$  being nitrogen, classified in class 514, subclass 241, 903.

Inventions I-II are unrelated to each other. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP 806.04, MPEP 808.01). In the instant case the inventions are separate and distinct each from the other because the compounds of Groups I-II differ by a significant structural feature, having different formula, which are classified in different subclass of class 514, for example a compound of formula I wherein a 6-membered ring contains 3 nitrogen atoms is

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classified in subclass 241, and a compound of formula I wherein a 6-membered ring containing 2 nitrogen atoms are classified in subclass 247.

Given the fact that chemical compounds that are not similar in structure have different physical, chemical, biological and physiological properties or activities, the instant compounds are deemed to have different modes of operation, different functions, and different effects.

Moreover, the search for inventions of Groups would place an undue burden on the Office because of their separate classification crossing class 514. It is noted that for example a reference to one compound of formula I wherein a 6-membered ring with 3 nitrogen atoms would not be a reference to another compound formula I, wherein a 6-membered ring with two nitrogen under 35 U.S.C. 103(a).

The above inventions differ as distinct therapeutic methods. The grouped inventions are patentably distinct, a reference which would anticipate, or make obvious, any inventions from groups I-II would not necessarily obviate or anticipate, the inventions in any other group. The searches are not co-extensive as indicated by the diverse nature of the subject matter. The search for all inventions would place an undue burden on the office in view of the diversity of treatment methods and the corresponding diversity in the field of search for each. Note that the search involves both patent and non-patent literature.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the office if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one or more claim remaining in the application. Any amendment of inventorship must be accompanied by request under 37 CFR 1.48(b) and by fee required under 37 CFR 1.17(i).

A telephone call to the applicant's agent to request an oral election was not made, due to the complexity of the restriction.

### ***Conclusion***

.Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shobha Kantamneni whose telephone number is 571-272-2930. The examiner can normally be reached on Monday-Tuesday, Thursday-Friday, 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Shobha Kantamneni

Patent Examiner

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER